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In re Application of
Antonius H.J. Gerrits et al
Application No. 09/916,491
Filed: July 27, 2001
Attorney Docket No. FCI-2699/4450G

OFFICE OF PETITIONS
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: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 4, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application (Application No. 09/748,503) set forth in the amendment filed November 25, 2002, and resubmitted with the instant petition.¹

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above. In this regard, the amendment, as currently worded, cannot be entered as filed since provisional Application No. 60/047,398 was filed more than one year from the instant prior-filed application, to priority is being claimed. It is

¹ The instant application was published on May 9, 2002 and contained a reference to nonprovisional Application No. 09/297,776 and provisional Application No. 60/047,398.

noted that intermediate Application No. 09/297,776 is a 371 of PCT/US97/14369, filed August 13, 1997, which claims benefit to the above-noted provisional application. Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. *See Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); *Hovlid v. Asari*, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). *See also* MPEP § 201.11. Every intermediate application must make a reference to the first (earliest) application and every application after the first application and before such intermediate application. Therefore, if appropriate, a reference to the PCT application in the amendment should be made in order to claim benefit of the above-noted provisional application.

If reconsideration of this decision is desired, a renewed petition under 37 CFR 1.78(a)(3), along with a substitute amendment correcting the above-noted deficiency, must be submitted, along with a renewed petition under 37 CFR 1.78(a)(3).

Further correspondence with respect to this matter should be addressed as follows:

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